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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* SHAHRAM MOSTAFAZADEH and JOSEPH O. SMITH

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Appeal 2009-004238  
Application 10/016,750  
Technology Center 2800

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Decided: December 14, 2009

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Before ALLEN R. MACDONALD, *Vice Chief Administrative Patent Judge*,  
FRED E. MCKELVEY, *Senior Administrative Patent Judge*, and  
JOHN A. JEFFERY, *Administrative Patent Judge*.

JEFFERY, *Administrative Patent Judge*.

ON REQUEST FOR REHEARING

Appellants request that we reconsider our Decision of August 27, 2009 (“Decision”) where we affirmed the Examiner’s rejection of claims 11-23 under 35 U.S.C. § 251 as improperly recapturing surrendered subject matter.

We have reconsidered our Decision in light of Appellants' arguments in the Request for Rehearing. We decline to make any changes in the Decision for the reasons that follow.

*Independent Claims 11 and 23*

We maintain our Decision affirming the Examiner's rejection of claim 11 under § 251 as improperly recapturing surrendered subject matter essentially for the reasons indicated in our Decision. In our Decision, we identified three limitations that narrowed the scope of independent claim 11 in the present reissue application, and acknowledged that these limitations were "overlooked" in the sense that they were not prosecuted in the parent application. Decision, at 16-17. We nevertheless held that these limitations are not "overlooked aspects" of the invention that *materially* narrow the claim in other respects to avoid recapture. *Id.* (emphasis in original) (citing *Hester Indus., Inc. v. Stein, Inc.*, 142 F.3d 1472, 1482-83 (Fed. Cir. 1998)).

In reaching this conclusion, we noted that the Manual of Patent Examination Procedure (MPEP) explains that when "the reissue claim(s) are really claiming additional *inventions/embodiments/species* not originally claimed (i.e., *overlooked aspects* of the disclosed invention), then recapture will not be present." Decision, at 16 (quoting MPEP § 1412.02(I)(C), 8th ed., Rev. 7, July 2008) (emphases in original)). We further noted the MPEP's illustrative examples in this regard. Decision, at 16-17. Based on this guidance, we held that "'overlooked aspects' of the invention are additionally *patentably-distinct* (1) inventions; (2) embodiments; or (3) species not originally claimed—not mere incidental features of the originally-claimed invention." Decision, at 17 (emphasis in original).

Applying this standard to reissue claim 11, we found that the narrowing limitations pertained to the same embodiment as the patented claims, namely a lead frame ball grid array (BGA) package (“the BGA embodiment”). Decision, at 19. Based on this finding, we held that claim 11 does not pertain to a patentably-distinct invention, embodiment, or species, but rather a different definition of the same subject matter. *Id.* We therefore concluded that these narrowing limitations were merely incidental to the essential characteristics of the BGA embodiment, and are therefore not “overlooked aspects” of the invention so as to *materially* narrow the claim in other respects to avoid recapture. *Id.* (emphasis in original).

Appellants argue that our Decision was erroneous since independent claim 11 purportedly recites limitations that are not merely incidental, but rather material to patentability. Request, at 6. According to Appellants, claim 11 is (1) directed to a different invention than the original patent, and (2) materially narrowed regarding aspects that were “overlooked” during the original prosecution. *Id.* Appellants make similar arguments regarding independent claim 23. Request, at 11.

To support these contentions, Appellants compare reissue claim 11 with and without the narrowing limitations, and argue that they essentially convert an otherwise unpatentable claim (calling for a lead frame) to a patentable one (calling for an integrated circuit package) over a Japanese prior art reference (JP 5-121631) (“Kawakimi”). Request, at 3-5.

We are not persuaded by this argument for two reasons. First, to the extent that claim 11's narrowing limitations render the claim patentable over Kawakimi is a question not before us, for the only rejection on appeal was a recapture rejection under § 251—not a prior art rejection. *See* Decision, at 3.

Second, even assuming that claim 11's narrowing limitations patentably distinguish over Kawakimi, claim 11 is still directed to the same embodiment as the patented claims, namely the BGA embodiment—an embodiment distinct from another embodiment in the patent directed to a pin-type IC module. Decision, at 18-19. Indeed, Appellants do not dispute this fact. And it is this distinctness that is critical in determining whether claim 11 constitutes an additionally patentably-distinct (1) invention; (2) embodiment; or (3) species not originally claimed—which it does not.

Although reissue claim 11 may include additional features including, among other things, a protective casing covering the die and lead frame, and exposing the bottom surfaces of the die attach platform, bus bar, and contacts, these features do not transform claim 11 to a patentably-distinct invention, embodiment, or species as compared to the patented claims. Rather, as we noted in our Decision, the claim merely sets forth a narrower scope of definition of the same subject matter as the patented claims. *See* Decision, at 18-19 (citing MPEP § 806.03). These incidental features therefore do not constitute “overlooked aspects” of the invention so as to *materially* narrow the claim in other respects to avoid recapture under § 251. *See* MPEP § 1412.02(I)(C).

Accordingly, we maintain our Decision affirming the Examiner's rejection of claim 11 under § 251 as improperly recapturing surrendered subject matter. We reach a similar conclusion regarding independent claim 19 which recites commensurate limitations.

*Independent Claim 19*

We also maintain our Decision affirming the Examiner's rejection of independent claim 19. As with claim 11, Appellants contend that since the narrowing limitations of claim 19 essentially convert an otherwise unpatentable claim into a patentable one, the claim is ostensibly directed to a different invention and therefore the additional features materially narrow the claim to avoid recapture. Request, at 7-8.

We are not persuaded by this argument, however, essentially for the reasons discussed previously. As we indicated in the opinion, although the four features added to claim 19 narrow the claim with respect to the patented claims, the features are nevertheless incidental to the essential characteristics of the BGA embodiment, and are not directed to a patentably-distinct invention, embodiment, or species. Decision, at 21-22. In short, these four features do not transform claim 19 to a patentably-distinct invention, embodiment, or species as compared to the patented claims. Rather, as we noted in our Decision, the claim merely sets forth a narrower scope of definition of the same subject matter as the patented claims. *See id.*

Furthermore, Appellants acknowledge that some of these added features are commensurate with those recited in the patent's original dependent claims 5 and 9, namely regarding (1) the integrated circuit chip includes ground I/O pads that are electrically connected to the die attach

platform, and (2) a protective casing encapsulating the lead frame and the chip (die).<sup>1</sup> Request, at 8. Since these features correspond to those recited in the original patent claims, they are not “overlooked” for that reason alone. *See Hester*, 142 F.3d at 1482-83.<sup>2</sup> That a particular originally-claimed element (e.g., electrically connecting the die’s ground pads to the die attach pad) was not mentioned during the prosecution of the original patent as Appellants contend (Request, at 9) does not somehow render the feature an “overlooked” aspect. To the contrary, the fact that it was originally claimed indicates just the opposite. *See id.*

Nevertheless, for the reasons noted previously, these narrowing features, along with those that were not originally recited, constitute incidental features that do not materially narrow the claim in other respects to avoid recapture under § 251. Accordingly, we maintain our Decision affirming the Examiner’s rejection of claim 19 under § 251 as improperly recapturing surrendered subject matter.

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<sup>1</sup> Specifically, Appellants acknowledge that original claim 5 recited an integrated circuit chip that (1) is mounted on the die attach pad, and (2) includes plural ground I/O pads that are electrically connected to a die attach platform. Request, at 8. Appellants further acknowledge that original claim 9 called for a protective casing that encapsulates the lead frame and the integrated circuit (die). *Id.*

<sup>2</sup> *See also Ex parte Bradshaw*, No. 2006-2744, 2007 WL 2138943 (BPAI 2007) (non-precedential), at \*9 (noting *Hester*’s exception to the recapture rule as requiring that (1) an aspect of the invention must have been overlooked (e.g., not claimed) during patent prosecution, and (2) the reissue claim must have been materially narrowed with respect to this overlooked aspect).

*Claims 15-18*

We will also maintain our Decision regarding claims 15-18 essentially for the reasons indicated above, as well as those in our Decision (Decision, at 20-21).

At the outset, we noted in our Decision that we deemed Appellants' separate arguments regarding claims 16 and 18 to be waived since they were not timely raised in the Appeal Brief. *Id.* n.9. Therefore, we decline to address Appellants' reference to these untimely arguments in the Request (Request, at 11).

In any event, as we indicated previously, exposing the bottom surfaces of the die attach platform, bus bar, and contacts does not transform independent claim 11 to a patentably-distinct invention, embodiment, or species as compared to the patented claims. We reach the same conclusion regarding the particular narrowing features of claims 15 and 17 that we identified in our Decision. Decision, at 20-21. Although we acknowledged that these features narrow the claims, we nonetheless emphasized that they are not directed to patentably-distinct inventions, embodiments, or species, and therefore do not constitute "overlooked aspects" of the invention to materially narrow the claim in other respects to avoid recapture. Decision, at 20-21.

Accordingly, we maintain our Decision affirming the Examiner's rejection of claims 15-18 under § 251 as improperly recapturing surrendered subject matter.



*Claims 20-22*

We will also maintain our Decision regarding claims 20-22 essentially for the reasons indicated above, as well as those in our Decision (Decision, at 23-24). Moreover, as noted in our Decision (*id.* at 20-21 n.9), Appellants' arguments regarding claim 22 (Request, at 13) were not timely raised and therefore were deemed waived. We therefore decline to address those untimely arguments here.

Accordingly, we maintain our Decision affirming the Examiner's rejection of claims 20-22 under § 251 as improperly recapturing surrendered subject matter.

*Ex parte Eggert*

Lastly, Appellants challenge the basis for our declining to follow the precedential Board decision *Ex parte Eggert*, 67 USPQ2d 1716 (BPAI 2003). Request, at 13-14. Although Appellants contend otherwise, we maintain that *Eggert* is inconsistent with the rationale expressed in the subsequent Federal Circuit decision, *North Am. Container, Inc. v. Plastipak Pkg., Inc.*, 415 F.3d 1335, 1349 (Fed. Cir. 2005). Decision, at 14 n.5. We therefore decline to follow this conflicting older Board precedent. *See* Standard Operating Procedure 2, *Publication of Opinions and Binding Precedent* ("SOP 2"), § VI(D) (BPAI Mar. 23, 2008), at 6 ("All judges, including the Chief Judge, are bound by a published or otherwise disseminated Precedential opinion of the Board *unless* the decision supported by the opinion is . . . inconsistent with a decision of the Supreme Court or *the Court of Appeals for the Federal Circuit . . .*") (emphases added).

To be sure, the authority we cited for the proposition that *Eggert* is no longer viable is an Informative Board decision, *Ex parte Liebermann*.<sup>3</sup> Although *Liebermann* is not binding, its status as an Informative decision nevertheless “illustrate[s] norms of Board decision-making for the public, the patent examining corps, and future Board panels,” and, notably, is circulated to the Commissioner for Patents. See SOP 2, § VII, at 6. As such, *Liebermann*’s abrogation of *Eggert* has been formally adopted to illustrate the norms of decision-making in broadening reissue appeals. See *id.*

Moreover, the Board’s later decision, *Ex parte Lanier*, cogently explains the underlying reasoning and policy considerations in abrogating *Eggert*:

There was a time when *Ex parte Eggert* . . . controlled proceedings in the USPTO. After *Eggert*, the MPEP was amended to “codify” USPTO practice to *Eggert*. See MPEP, § 1412.02 (I.C.) (8th ed., rev. 2, May 2004 through rev. 6, Sept. 2007). *Eggert* did not have a long life. Why? Along came *North American Container, Inc. v. Plastipak Packaging, Inc.*, 415 F.3d 1335 (Fed. Cir. 2005). Some members of the Board viewed *North American* as being inconsistent with *Eggert*. I leave it to a scholarly law review article to debate the issue of whether a Federal Circuit opinion in an *inter partes* infringement case can bind the Director when the Executive branch is not a party to the appeal. What is not debatable is that

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<sup>3</sup> *Ex parte Liebermann*, No. 2007-0012, 2007 WL 5211672 (BPAI 2007) (Informative), at \*11-12, available at <http://www.uspto.gov/web/offices/dcom/bpai/its/fd070012.pdf> (noting that *Eggert* is inconsistent with the rationale expressed in *North American Container* and should no longer be followed or apply to USPTO proceedings). Accord *Ex parte Olson*, No. 2008-6351, 2009 WL 1817909 (BPAI 2009) (non-precedential), at \*10-11 (citing cases).

a majority of the Board members in *Kraus, Browning* and this appeal upon considering the rationale of *North American* versus the rationale of the *Eggert* majority have determined that the *North American* rationale is the better rationale. *Eggert* therefore “had to go.” The *Eggert* “had to go” decision is consistent with the proposition that Federal Circuit precedent on a question of law trumps Board precedents—even precedential Board decisions.

The Director has agreed that *Eggert* no longer states applicable law, and has revised the MPEP to abrogate the *Eggert* rule in USPTO practice. See MPEP, § 1412.20 (I.C.) (8th ed., Rev 7, July 2008).

Since *Kraus*, and other Board recapture decisions . . . , the 5,000+ USPTO examiners have applied the current July 2008 MPEP recapture policy. Despite numerous decisions of this Board applying what is now reflected in the July 2008 MPEP policy, no applicant has sought judicial review despite the seemingly important legal issue raised by the policy. At this point, I simply cannot vote to go the other way and thereby created a “shifting sand” basis upon which examination is to be carried out. It simply is not fair to the Patent Corps or to reissue or potential reissue applicants who rely on stated policies of the USPTO.

The *ex parte* patent system is set up to permit an applicant dissatisfied with our decision to seek judicial review. 35 U.S.C. § 141 (Federal Circuit) and § 145 (District Court). The Examiner—or for that matter the Director—cannot seek judicial review. For practical reasons based on long-standing *stare decisis* and Anglo-Saxon jurisprudential considerations, the Board generally gives binding effect to decisions of its appellate reviewing courts—the Federal Circuit and where applicable the Supreme Court.

It is difficult to administer the patent examination and the overall patent system in a fair and even-handed manner when (1) a Federal Circuit decision is entered subsequent to a

decision by the USPTO to adopt a Board decision as “binding” (i.e., *Eggert*) and (2) the Federal Circuit decision is at least debatably “inconsistent” with our “binding” Board decision. If the Federal Circuit decision is “on all fours” factually, then our “binding” “precedent” is no longer viable and should not be followed. Even if a subsequent Federal Circuit is not on all fours, an argument can be made that the Board should reevaluate its position in the face of Federal Circuit rationale. *Cf. Teva Pharmaceuticals USA, Inc. Novartis Pharmaceuticals Corporation*, 482 F.3d 1330, 1347 (Fed. Cir. 2007) (Friedman, Senior Circuit Judge, concurring). Stated in other terms, for policy reasons the Director may adopt what might be regarded as dictum in a Federal Circuit opinion, leaving it to the court to resolve the correctness of the dictum in a subsequent case. *See, e.g., In re McGrew*, 120 F.3d 1236 (Fed. Cir. 1997). *See also In re Deckler*, 977 F.2d 1449 (Fed. Cir. 1992). For this reason, a member of the Board who is of the view that *North American* trumps *Eggert* may legitimately decline—respectfully—to follow *Eggert*.

*Ex parte Lanier*, No. 2007-3925, 2009 WL 789925 (BPAI 2009), at \*27-28 (McKelvey, J., concurring).

Turning to the merits of Appellants’ argument, Appellants contend that since *North American Container* does not relate to the broadening issue in *Eggert*, *Eggert* remains good law. Request, at 14. Appellants emphasize that *North American Container* related to a situation where the applicant intended to *completely eliminate* a limitation argued during prosecution, but *Eggert* held that a reissue claim can broaden a limitation introduced during prosecution, but cannot completely eliminate it. *Id.* According to Appellants, this latter *Eggert*-type situation—not the *North American Container* situation—applies to the claimed attachment pad feature in the present reissue application. *Id.*

To be sure, the *North American Container* court held that deleting the “generally convex” limitation with respect to the “inner walls” limitation in that case impermissibly recaptured surrendered subject matter since the deleted language was critical in overcoming a prior art reference during prosecution of the original patent. *North Am. Container*, 415 F.3d at 1350. In reaching this decision, however, the court emphasized that it is *irrelevant whether the claims as a whole are of “intermediate scope”*: the recapture rule is applied on a limitation-by-limitation basis. *Id.* (emphasis added).

*Eggert* conflicts with the Federal Circuit rationale for it was this very “intermediate scope” rationale that formed the basis for the *Eggert* majority’s conclusion that there was no recapture in that case. *See Eggert*, 67 USPQ2d at 1717-18 (holding that broadening the scope of an issued claim via reissue to have a scope *between* that of the issued claim and the rejected claim does not impermissibly recapture surrendered subject matter under § 251).

In view of this conflict, we therefore decline to follow *Eggert*, and, as such, maintain that Appellants’ broadening of the attachment pad limitation to an intermediate scope constitutes an impermissible recapture of surrendered subject matter for the reasons indicated in our opinion. *See Decision*, at 12-19.

## CONCLUSION

For the foregoing reasons, we have granted Appellants’ request to the extent that we have reconsidered our Decision of August 27, 2009, but we deny the request with respect to making any changes therein.

Appeal 2009-004238  
Application 10/016,750

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REHEARING DENIED

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